

Appln. No. 10/782,111
Amendment dated October 7, 2004
Reply to Office Action mailed July 8, 2004

REMARKS

Reconsideration is respectfully requested.

Claims 1 through 12 remain in this application. Claims 2 and 3 have been cancelled.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Paragraphs 1 and 2 of the Office Action

Claims 1-3, 5-8 and 10-11 have been rejected under 35 U.S.C. §102(b) as being anticipated by Billings et al, hereinafter Billings.

It is submitted that the Billings reference does not disclose, teach or suggest "said neck portion having a length greater than a length of said handle portion to permit the user to be positioned to remain unnoticed by the person". The Billings reference teaches a hand-held sound generating device that fails to teach the neck portion having a length greater than a length of the handle portion to allow the user to position themselves to remain unnoticed by the person as claimed by the applicant. Therefore, it is submitted that that Billings reference would not lead one to the combination of features as claimed by the applicant.

Claims 5 through 8, 10 and 11 are dependent upon claim 1, particularly as amended, and therefore incorporate the requirements of claim 1. Thus, claims 5 through 8, 10 and 11 are also believed to be allowable over the cited reference.

Claims 2 and 3 have been cancelled.

Withdrawal of the §102(b) rejection of claims 1-3, 5-8 and 10-11 is therefore respectfully requested.

Paragraph 3 of the Office Action

Claims 1-3 and 5-8 have been rejected under 35 U.S.C. §102(b) as being anticipated by Sikes.

Appln. No. 10/782,111
Amendment dated October 7, 2004
Reply to Office Action mailed July 8, 2004

It is submitted that the Sikes reference does not disclose, teach or suggest "said housing member comprising a neck portion, said neck portion being coupled to said handle portion of said housing member such that said neck portion extends outwardly from said handle portion, said speaker member being coupled to said neck portion opposite said handle portion of said housing member, said neck portion being elongated such that said neck portion is adapted for permitting a user to stand at a distance from the person when the user actuates said actuation assembly" and "said neck portion having a length greater than a length of said handle portion to permit the user to be positioned to remain unnoticed by the person". The Sikes reference teaches an alarm clock system with an ear insert that fails to teach housing member having a neck portion that extends outwardly from the handle portion to allow the user to be positioned at a distance from the person they are trying to distract and that the handle portion is longer than the handle portion to facilitate the positioning of the user to inhibit the user being noticed by the person as claimed by the applicant. The Office Action states:

"..., a neck portion [area between housing 26 and speaker housing 36] extending outwardly from the handle portion, ..."
being that the reference number "36" represents the entirety of the speaker housing and there are no additional numbers on the article indicated by reference number "36" it is believed that the Office Action is indicating that the top housing plate "44" is to be representative of the neck portion of the applicant's claims. The top housing plate "44" is mounted in the insert housing "26" which can be clearly seen from Figure 2, of the Sikes reference. Thus, the Sikes reference fails to meet the requirement that the neck portion extend outwardly from the handle portion as is required by the applicant's claims. Further, for claims to be anticipated by a reference that reference must describe every element of those claims as well as those elements must be arranged as is required by the claims as expressed in MPEP 2131 stated below.

Appln. No. 10/782,111

Amendment dated October 7, 2004

Reply to Office Action mailed July 8, 2004

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

"The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required. In *re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Note that, in some circumstances, it is permissible to use multiple references in a 35 U.S.C. 102 rejection. See MPEP § 2131.01."

Therefore, it is submitted that the Sikes reference would not lead one to anticipate the combination of features as claimed by the applicant.

Withdrawal of the §102(b) rejection of claims 1-3 and 5-8 is therefore respectfully requested.

Paragraph 4 of the Office Action

Claims 1-2 and 5-8 have been rejected under 35 U.S.C. §102(b) as being anticipated by JP 6132623, hereinafter JP '623.

It is submitted that the JP '623 reference does not disclose, teach or suggest "a speaker member being coupled to said housing member, said speaker member being operationally coupled to said actuation assembly such that said speaker member is adapted for being actuated by said actuation assembly to produce the nuisance noise when said actuation assembly is actuated, said housing member being adapted for being selectively manipulated by the user to direct said speaker member towards an ear of the person to distract the person with the nuisance noise when said actuation assembly is actuated by the user" and "said neck portion having a length greater than a length of said handle portion to permit the user to be positioned to remain unnoticed by the person". The JP '623 reference fails

Appln. No. 10/782,111
Amendment dated October 7, 2004
Reply to Office Action mailed July 8, 2004

to teach the neck portion being longer than the handle portion as well as the speaker member being coupled to the housing and the speaker member coupled to the housing as is required in the applicant's claims. The JP '623 reference teaches a switch "7" being coupled to the end of housing member that is for resetting the sound and therefore leaves any type of sound producing means being positioned on the circuit board which is suspended in the housing and therefore not directly coupled to the housing as required by the applicant's claims. Further, for claims to be anticipated by a reference that reference must describe every element of those claims as well as those elements must be arranged as is required by the claims as expressed in MPEP 2131 stated below.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

"The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. In *re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Note that, in some circumstances, it is permissible to use multiple references in a 35 U.S.C. 102 rejection. See MPEP § 2131.01."

Therefore, it is submitted that the JP '623 reference would not lead one to anticipate the combination of features as claimed by the applicant.

Withdrawal of the §102(b) rejection of claims 1-2 and 5-8 is therefore respectfully requested.

Paragraphs 5 and 6 of the Office Action

Claim 4 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Sikes in view of Smith et al, hereinafter Smith.

Appln. No. 10/782,111
Amendment dated October 7, 2004
Reply to Office Action mailed July 8, 2004

The law regarding obviousness is clear--any modification of the prior art must be suggested or motivated by the prior art:

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

It is submitted that the combination of Sikes with Smith is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims. In particular, the references do not disclose, teach or suggest "said neck portion having a length greater than a length of said handle portion to permit the user to be positioned to remain unnoticed by the person" and "said neck portion comprising a resiliently flexible material, said resiliently flexible material permitting said neck portion to bend in a variety of positions to allow the user control of the direction from which the user introduces the nuisance noise produced by said speaker member to the person". The Sikes reference teaches an alarm clock system with ear insert that fails to teach the neck portion of the housing member comprising a resiliently flexible portion for be bent as necessary to allow the user to control the direction from which the sound is coming from and as discussed above, fails to teach the neck portion being longer than the handle portion as claimed by the applicant. The Smith reference teaches a flexible ear insert and audio communication link that fails to teach the neck portion being longer than the handle portion to allow the user to position

Appln. No. 10/782,111
Amendment dated October 7, 2004
Reply to Office Action mailed July 8, 2004

themselves to avoid being noticed by the person as claimed by the applicant. Additionally, the Office Action states that the Smith reference teaches that it is well known in the art to provide a flexible ear insert and yet that claimed by the applicant makes no limitations that any portion of that claimed by the applicant is to be inserted into the ear of the user as is required by both the Sikes and Smith references and there is a complete lack of motivation for such a combination other than improper hindsight of the applicant's claims. It is respectfully submitted that the Examiner has improperly used applicant's claims as a recipe for selecting and combining isolated elements of various references and has used the benefits achieved by applicant's claimed structure--benefits described only in applicant's disclosure--in hindsight as the motivation for making the asserted combination of references.

Presuming arguendo that the references show the elements or concepts urged by the examiner, the examiner has presented no line of reasoning, and we know of none, as to why the artisan viewing only the collective teachings of the references would have found it obvious to selectively pick and choose various elements and/or concepts from the several references relied on to arrive at the claimed invention. In the instant application, the examiner has done little more than cite references to show one or more elements or subcombinations thereof, when each is viewed in a vacuum, is known. The claimed invention, however, is clearly directed to a combination of elements. That is to say, appellant does not claim that he has invented one or more new elements but has presented claims to a new combination of elements. To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

Ex parte Clapp, 227 USPQ 972, 973 (PTO Bd. App. 1985).

The applicant's claims use the resilient flexible material to allow the speaker member to be positioned to allow the user a variety of positions with which to direct the sound towards the person's ear which is not taught by the Smith reference which teaches the flexible ear insert to conform to

Appln. No. 10/782,111
Amendment dated October 7, 2004
Reply to Office Action mailed July 8, 2004

the ear of the user. Therefore, it is submitted that the combination of the Sikes reference with the Smith reference would not lead one to the combination of features as claimed by the applicant.

Withdrawal of the §103(a) rejection of claim 4 is therefore respectfully requested.

Paragraph 7 of the Office Action

Claim 9 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Sikes in view of Shields.

The law regarding obviousness is clear--any modification of the prior art must be suggested or motivated by the prior art:

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

It is submitted that the combination of Sikes with Shields is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims. In particular, the references do not disclose, teach or suggest "said neck portion having a length greater than a length of said handle portion to permit the user to be positioned to remain unnoticed by the person". As discussed above, the Sikes reference fails to teach the neck portion being longer than the handle portion to allow the user to position themselves to remain unnoticed by the person as claimed by the applicant. The Shields

Appln. No. 10/782,111
Amendment dated October 7, 2004
Reply to Office Action mailed July 8, 2004

reference teaches a portable timer-alarm that fails to teach the neck portion being longer than the handle portion to allow the user to position themselves to remain unnoticed by the person as claimed by the applicant. Therefore, it is submitted that the combination of the Sikes reference with the Smith reference would not lead one to the combination of features as claimed by the applicant.

It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious--there must be a motivation provided by the prior art, and that motivation is totally lacking in the reference.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape *** since *this is within the capabilities of such a person.*" Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980)
(emphasis in original).

Withdrawal of the §103(a) rejection of claim 9 is therefore respectfully requested.

Paragraph 8 of the Office Action

Claim 12 is allowed.


Appln. No. 10/782,111
Amendment dated October 7, 2004
Reply to Office Action mailed July 8, 2004

CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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